



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------------|
| 10/796,025 | 03/10/2004 | Wataru Tazoe | 503.43626X00 | 2138 |
| 20457 7590 10/12/2007 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873 | | | EXAMINER HAND, MELANIE JO | |
| | | | ART UNIT 3761 | PAPER NUMBER |
| | | | MAIL DATE 10/12/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

8

| | | | |
|---|--------------------------------------|-------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/796,025 | Applicant(s) TAZOE ET AL. | |
| | Examiner Melanie J. Hand | Art Unit 3761 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 18-24.
 Claim(s) withdrawn from consideration: _____.


AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

TATYANA ZALUKAEVA
 SUPERVISORY PRIMARY EXAMINER

MJH


Continuation of 11. does NOT place the application in condition for allowance because: With respect to applicant's arguments regarding the rejection of claims 18 and 22 as unpatentable over Lawrence in view of Conkling: As an initial matter, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that Lawrence teaches a coverstock that is hydrophobic yet capable of breathing and thus does not keep the urine absorbent material highly airtight. This is not found persuasive because "highly airtight" is not sufficiently defined in the disclosure and is thus given a meaning for examination purposes that is equal to "airtight". The fact that the coverstock of Lawrence is capable of breathing does not completely render the coverstock incapable of keeping the absorbent material airtight along with the impermeable outer sheet. In fact the invention as claimed in claim 18 sets forth that "urine is absorbed into said urine absorbent material through a hole on said top sheet upon wearer's urination." This is interpreted herein as a further limiting description of applicant's term "highly airtight" in that the topsheet is airtight to the extent that a topsheet having a hole therein can be airtight.

With respect to applicant's arguments regarding the prior art of Conkling, these arguments have been fully considered but are not persuasive as Applicants' arguments depend entirely on Applicants' arguments regarding the rejection of claims 18 and 22, which have been addressed supra.

With respect to applicant's arguments regarding the rejection of claims 19-21, 23 and 24 over Lawrence in view of Conkling and further in view of Reed, applicant argues that Reed pertains to a wound dressing and does not seek to solve the same problem as the claimed invention. This is not found persuasive because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant further argues that "Examiner admits that the Reed et al patent does not have the dry breathability characteristics set forth in claims 20, 21, 23 and 24". This is not found persuasive. Applicant is referred back to the Office action on page 6 where it is clear in the rejection of claims 20, 21, 23 and 24 that it is acknowledged by the Office that Lawrence in view of Conkling (not Lawrence in view of Conkling and further in view of Reed) does not teach a particular breathability. Thus applicant's argument is insufficient and moot. With respect to the combined teaching of Lawrence and Conkling and Reed, it is also clear the claim is rejected on an argument of inherency, yet applicant does not address any supposed errors in the inherency argument presented by the Office. Applicant is encouraged in any response to this Office action to more fully and properly argue the rejection of claims 20, 21, 23 and 24 to overcome said rejection.